REMARKS/ARGUMENTS

1.   <u>Rejection of Claims 1-10 and 17-28 under 35 U.S.C. 103(a)</u>.

Claims 1-10 and 17-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schleifer (U.S. Pat. No. 7,526,768) in view of the LaRue (U.S. Publ. No. 2002/0133508). Claims 1, 10, 17 and 24-28 are the independent claims pending within the instant case.

(a) <u>Claim 1</u>. Claim 1 is an independent claim directed to a method of tracking and synchronizing content across multiple devices, including a plurality of client devices and a server.

In support of the rejection a number of elements are advanced from the Schleifer reference, and a combination asserted with the LaRue reference.

However, in carefully examining these elements it can be seen the combination of references does not teach every element recited in Applicant claims.

In particular, the issue continues to arise regarding what is meant by "*new content*" as recited in applicant claims. The claim specifically recites that "*new content*" is "*content for which no record exists*". It does not say for which no record exists on the device receiving the content. The references cited have all been directed toward passing a content record to a device that does not contain that content record. But if a content record is being passed, then it EXISTS. The application abundantly describes, such as on page 14, lines 8-20, that a new content item is "*content without a record*" and that it is "*'new' content to the system*".

It should be appreciated that for the case of "content containing images" as recited in the amended instant claims and specification, the content is a media containing images, but a content record associated with that content is a database structure (entity) which contains the content, or more usually a pointer to the content, along with fields which include some form of record ID, and other information about the content.

Passing of content records, not "*new content for which no record exists*", is what is described in the cited references. Schleifer reference receives <u>a record</u> from another device and seeks to synchronize that record on the given device. The rejection admits that Schleifer lacks a proper teaching of new content and asserts a combination with LaRue to overcome these shortcomings. Yet the LaRue reference is directed to incorporating existing records of a dataset into a "<u>Grand Unified Dataset" (GUD)</u>, as will be described in a section below. <u>Therefore, LaRue is taking an existing record of a first database and adding the GUD identifier when this record is subsumed into the GUD;</u> **<u>it is not therefore operating on new content for which no record exists</u>**.

In order to further focus the examination, the independent claims have been amended to recite that the content being described contains some form of image content, which can include "*video tracks, graphic images, and photographs*", which are types described in the background of the invention on page 1, lines 11-15 of the instant application, and the only types of content for which the image analysis is performed when comparing new content to existing content. These aspects were contained in a portion of the independent claims in prior amendments, but were not properly considered on their own merits; as the rejection of each independent claim was improperly based solely on the material of independent Claim 1. The amended claims thus bring this material up into even Claim 1.

When new content is received, it is this image-containing content which is compared with existing records in the preferred embodiments. On page 14, line 20 through page 15, line 3 image content in the form of photographs is described as follows: "*if the image content is a digital photograph, the image of the new content is compared against the image of existing content via an image analyzer.*" This image comparison aspect is described in existing Claim 18 of the application.

As described above, the LaRue reference does not describe "*receiving new content for which no record exists*", while it provides no teaching and support of synchronizing <u>content containing images</u>, <u>or more particularly does not teach comparing content containing images with a comparison that includes image analysis,</u> as described

by the amended claims. Consequently the LaRue reference in combination with Schleifer fails to teach all aspects of the invention as recited in Applicant claims. The following discussion makes it plain that LaRue is not dealing with "content for which no record exists", but of receiving a record, adding fields to it for inclusion within a higher level global database.

The following looks more closely at the "*System and Method for Synchronizing DATASETS Using Cooperation Among Multiple Synchronization Engines*", as recited as the title of the LaRue reference.

Paragraph [0010] of that reference, duplicated below, describes its object.

> *The present invention relates generally to synchronization of data-that is, the process of taking* **two or more separate collections of data ("datasets")** *and applying* <u>changes</u> *to one or more of the datasets* **to make the datasets identical or equivalent**. *The present invention is particularly relevant to synchronization involving a dataset that may separately synchronize with multiple other datasets at various times, especially if the other datasets may also synchronize with one another.*

LaRue itself defines a "*dataset*" as a separate collection of data. To be contained in a collection, a piece of data must be identified, whereby it of necessity is part of a record. LaRue in paragraph [0020] describes these records, **"...*data records of particular multiple datasets*"**. Additionally, that same paragraph of the summary of the Invention of LaRue describes "<u>*when datasets being synchronized are found to contain mutually duplicative* **data records**</u>, *the data records are intelligently mapped to each other as being corresponding so as to avoid or minimize causing of changes to be made, in the data records, that would make synchronization status information stored in another dataset to become obsolete.*"; which further highlights needs fulfilled by the LaRue reference and pre-existence of content within records. <u>Accordingly, LaRue clearly describes synchronizing content **for which a record exists**, and thus is not directed at "*receiving new content for which no record exists*" as recited in Applicant claims.</u>

In the LaRue reference, these datasets from different systems are put in a
"Grand Unified Dataset" (GUD), into which the other datasets are subsumed. LaRue
describes this in paragraph [0038]-[0039] duplicated below.

> [0038] A. The Baseline Multi-point Hub-and-spoke Synchronizer.
> [0039] The hub-and-spoke synchronization configuration was discussed
> in the Background section in connection with FIG. 1. A baseline multi-point
> synchronization system from Starfish uses the hub-and-spoke configuration to
> good advantage. The baseline Starfish system uses the hub dataset 105 as the
> system's reference dataset or **Grand Unified Dataset" (GUD)**. The baseline
> Starfish system stores into the hub dataset 105 not only the latest user data but
> also status information about such user data relating to all datasets of the hub-
> and-spoke configuration.

The use of the GUD allows a superset of storage above the datasets, for storing
information about the synchronization, such as described in paragraph [0055] of LaRue
which recites "*The synchronizers store such exchanged knowledge in their respective
reference datasets (e.g., GUDs). The synchronizers can exchange such knowledge
during, for example, a synchronization between the synchronizers.*"

In view of the above context, paragraphs [0062], [0146], [0153] and [0171] of
LaRue asserted in support of the rejection can be more properly understood.

Paragraph [0146] of LaRue is asserted in support of "*receiving new content for
which no record exists*", although no specific texts from that lengthy paragraph are
given. Applicant presumes that the reference to "*creates a new and empty GUD record
and maps the received changed <u>client record</u> to the new GUD record*", was what was
relied upon. <u>However, in the sentence itself we see that there is already in existence a
record for the client content</u>, and this is merely being subsumed within the Global
Unified Dataset (GUD). This is all the more apparent when one considers the first
portion of the paragraph, such as the statement: "*<u>The synchronizer also receives, from
the client synchronizer, all changes to the **record-field mappings for all records** with
regard to all clients of the client synchronizer.</u>*" It is seen that LaRue here is clearly NOT
discussing content for which no record exists, but a record which has not been
incorporated into the universal mapping of the GUD.

Paragraph [0153] is asserted in support of the automatic field completion. Two intractable problems arise with this assertion. First, the cited paragraph only discusses mapping of records which already exist on other synchronizers into the GUD. These records already exist, so that the record is not being created in response to "*receiving new content for which no record exists*", as recited in Applicant Claim 1. Secondly, there is no discussion of the image content elements recited in amended Claim 1, and nothing in regard to performing a comparison which involves image analysis.

Paragraph [0171] of LaRue is asserted in support of "*automatically completing fields within said new content record based on information contained in the new content as well as information about the presence of duplicate or related content which is available on the multiple devices*". However, Claim 1 recites these fields being completed in creating a new content record for the content for which no record previously existed. The cited paragraph, and LaRue in general, is directed to synchronizing existing records from a synchronizers into the GUD structures. This is also seen in the cited paragraph, which starts by stating: "*In the step 710, if still no GUD record is yet identified or mapped to the **received client record**". So right there we see that a **record** has been received, which clearly contradicts "*receiving new content for which no record exists across any of the multiple devices*" as required by the recitations of instant Claim 1.

Paragraph [0062] from LaRue is asserted in support of "*updating the records of duplicate or related content with information about the new content…*". However, the paragraph does not discuss using "*information contained in the new content*", and more particularly "*information contained in the new content and said image analysis*", as recited in Claim 1.

Clearly support is lacking from the combination of LaRue with Schleifer for a number of the elements of the recited claim. In order to reject a claim based on obviousness all claim limitations must be taught in the combination as explained in MPEP 2143 as follows:

2143.03 All Claim Limitations Must Be Taught or Suggested
To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Accordingly it is seen that the combination of LaRue does not overcome the shortcomings of the Schleifer reference in regard to the previous unamended versions of Applicant claims, and now more markedly lacks merit with regard to the amended form of the independent claims which are directed to image containing content, and specifics thereof.

Consequently, it has been shown that the combination of LaRue with Schleifer does not teach all claim elements and their interdependencies, whereas support is lacking for a *prima facie* rejection of Claim 1.

Therefore, Applicant respectfully requests that the rejection of Claim 1, and the claims that depend therefrom, be withdrawn and the instant case allowed to issue.

(b) <u>Claims 10, 17 and 24-28</u>. Claims 10, 17 and 24-28 are independent claims, that contain recitations similar to those in Claim 1 discussed above, and have been amended in a similar manner as Claim 1. Applicant incorporates by reference its discussion above as also being generally applicable to Claims 10, 17 and 24-28, and requests that those claims be allowed for the same reasons that Claim 1 is allowable.

In addition, Claims 10, 17 and 24-28 contain limitations that the Examiner did not address in the Office Action. Those limitations provide an additional basis for patentability of those claims.

The Applicant draws attention, for example, to independent Claim 10, which is a system claim written in a means-plus-function format (for which Donaldson issues arise with respect to the examination discussed in a later section). Claim 10 recites "*means for receiving a request from a user to create a new content record for new content*

received from the user for which no record exists across any of the multiple devices".
The Schleifer / LaRue combination does not teach this means element.

Consider also independent Claim 17, which is directed to "*a system for tracking and synchronizing content containing images across multiple devices, including a plurality of client devices and a server*". This claim is patentable over the Schleifer / LaRue combination for the reason that the claim recites how new content is handled by the system in a manner similar to that recited in Applicant's Claim 1, which has been previously discussed. However, Claim 17 also recites operations within an interface module which receives "*a request submitted by a user specifying new content submitted by the user.*" This element is not taught by the Schleifer / LaRue combination. Claim 17 also recites "*said interface module is configured for communicating over a network between one or more client devices and a server device*", for which no support has been provided in the rejection. Claim 17 also recites "*said review module configured for selectively transmitting a confirmation for the request based on the analysis and the presence of duplicate or related content and the preference for determining whether the request is performed*", for which nothing is provided in support of the rejection. Neither of those elements are taught by the Schleifer / LaRue combination .

Independent Claim 24 recites "*A computer-readable medium having computer executable instructions for performing tracking and synchronizing content containing images across multiple devices, including a plurality of client devices and a server.*"
This claim is patentable over the Schleifer / LaRue combination for the reason that the claim recites how new content is handled by the system in a manner similar to that recited in the Applicant's Claim 1, which has been previously discussed. However, Claim 24 also recites additional limitations not found in the Schleifer / LaRue combination. For example, Claim 24 also recites "*selectively transmitting a confirmation for the request based on said reviewing and the presence of any duplicate or related content*" and "*performing the request based on receiving the request and instruction from the user in responding to said confirmation*"; for which no support is given in the rejection.

Independent Claim 25 recites a system for synchronizing and tracking content across multiple devices, including a plurality of client devices and a server. This claim is patentable over the Schleifer / LaRue combination for the reason that the claim recites how new content is handled by the system in a manner similar to that recited in the Applicant's Claim 1, which has been previously discussed. However, Claim 25 also recites additional limitations that are not met by the Schleifer / LaRue combination. For example, Claim 25 recites both "*automatically completing fields within said new content record based on information contained in the new content and said image analysis as well as information about the presence of duplicate or related content in existing content available across the multiple devices*" as well as "*automatically updating content record fields associated with existing content in response to receipt of new content which is found to be a duplicate or related to the existing content*", which is not addressed in the rejection, nor for which teachings are advanced from the relied-upon references. Further, Claim 25 recites "*transmitting a confirmation for the request when duplicate or related content is available*" and also recites "*receiving instruction from the user in responding to said confirmation*". None of these elements are taught by the Schleifer / LaRue combination.

Independent Claim 26 recites a "*system for synchronizing and tracking content containing images across multiple devices, including a plurality of client devices and a server*". This claim is patentable over the Schleifer / LaRue combination for the reason that the claim recites how new content is handled by the system in a manner similar to that recited in the Applicant's Claim 1, which has been previously discussed. However, Claim 26 also recites additional limitations that are not taught by the Schleifer / LaRue combination. For example, Claim 26 recites "*storing a preference setting for one or more types of requests*", "*transmitting a confirmation for the request based on the preference setting*", and "*receiving instruction from the preference setting, and/or from the user in responding to said confirmation, as to how to execute said request*". The rejection fails to provide support for these elements in the relied-upon Schleifer / LaRue combination.

Independent Claim 27 recites a client apparatus in a client-server configuration having similar additional limitations as Claim 26, and is patentable over the Schleifer / LaRue combination for the reasons given in regard to Applicant's Claim 1. In addition, Claim 27 also recites the confirmation elements described for Claim 26 above.

Independent Claim 28 recites a client apparatus in a client-server configuration having similar limitations as Claim 26, and is patentable over the Schleifer / LaRue combination for the same reasons as discussed for Applicant's Claim 1. Additionally, Claim 28 recites further limitations, including confirmations as described in Claim 26-27.

In view of the above, it will be seen that each of the foregoing independent claims is should be considered patentable over the Schleifer / LaRue combination.

Therefore, the Applicant respectfully requests that the rejection of Claims 10, 17, and 24-28, and the claims that depend therefrom, be withdrawn and that those claims be allowed.

(c) <u>Claim 18</u>. In addition to failing to consider the unique recitations of independent Claims 17 and 24-28 over the broader independent Claim 1, the rejection does not address the material recited in dependent Claim 18. Instead the rejection lumps Claim 18 in with Claim 1, and provides no basis for the rejection.
<u>Dependent Claim 18 recites "*a capture module configured to identify content in response to comparing an image of the new content with images contained in the existing content*", for which no support has been advanced from the cited combination of references</u>.

(d) <u>Claims 2-9, and 19-23</u>. Claims 2-9 and 19-23 depend from independent Claims 1 and 17 respectively, whose patentability over the Schleifer / LaRue combination has been demonstrated.

Accordingly, each of these dependent claims should be considered *a fortiori* allowable for at least the reasons given for overcoming the rejection of their parent claims, a while a number of these claims may contain additional grounds for patentability.

Therefore, Applicant respectfully requests that the rejection of Claims 2-9 and 19-23 be withdrawn, and the instant claims allowed to issue.

2.   Traversal of Rejection of Claim 10; In re Donaldson.

The Applicant respectfully traverses the grounds for rejection on Claim 10, and cites *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc) as the basis for the traversal. Claim 10 which is written in means plus function form pursuant to 35 U.S.C. §112, sixth paragraph, and therefore, must be interpreted during examination under *In re Donaldson*.

In rejecting Claim 10 the Examiner made no specific fact findings as to the scope of equivalents for the means plus function elements in the claims. Instead, the Examiner appears to have followed the provisions of MPEP § 2183 ("Making a Prima Facie Case of Equivalence"), which states:

> If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure ... disclosed in the application. *In re Mulder*, 716 F.2d 1542, 219 U.S.P.Q. 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent.

While the Examiner appears to have followed the provisions of MPEP §2183, such provisions are contrary to Federal Circuit law. The Federal Circuit has held that an examiner "construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof," *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc), and in so ruling expressly denied that "the PTO is exempt from this mandate." Id. The Federal Circuit added that it was specifically overruling any precedent that suggested or held to the contrary. Id. at 1193-94. In response to the PTO's argument that the court's ruling conflicted with the principle that a claim should be given its broadest reasonable interpretation during prosecution, the Federal Circuit held that

the Donaldson decision was setting "a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.'" Id. at 1194. In other words, an examiner's claim interpretation is not "reasonable" if it is not based on the specification's description of the implementation of the means element of the claim. The court then said, "Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such [means-plus-function] language when rendering a patentability determination. " Id. at 1195.

Here, as in *Donaldson*, the Examiner is required by statute to look to the Applicant's specification and construe the "means" language as referring to corresponding means disclosed in the specification and equivalents thereof." See id. at 1195. However, the Examiner did not construe the means language of these claims, however. Nor did the Examiner find, on the basis of specific facts of record here, that the means disclosed in the Applicant's specification were equivalent to that of the cited references. Instead, as prescribed by MPEP §§ 2183-84, the Examiner simply presumed equivalence. The presumption methodology used here, which the MPEP prescribes, clearly conflicts with the requirements of the Federal Circuit's Donaldson decision. The approach taken by the Examiner in this case also conflicts with *In re Bond*, 931 F.2d 831 (Fed. Cir. 1990).

The very point of these cases is that, in this context, limitations from the specification control the interpretation of the claim. Under §112, paragraph 6, a means-plus-function element of a claim must be construed to mean that which is disclosed in the specification and its equivalents. In *Donaldson*, the Federal Circuit said that "our holding does not conflict with the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim." In other words, the court was saying that a §112, paragraph 6 "means" element does not need to be "imported or read into" a means-plus-function claim because the specification's limitations and their equivalents are already in the claim by virtue of §112, paragraph 6's command. Thus, the Federal Circuit said (16 F.3d at 1195): "What we are dealing with in this case is the construction

of a limitation already in the claim in the form of a means-plus-function clause and a statutory mandate on how that clause must be construed."

Based on the foregoing, the Applicant respectfully submits that the rejection of Claim 10 lacks proper foundation and that the rejection should be withdrawn. Claim 10 which includes means plus function limitations, should have been interpreted in view of the specification as required by *In re Donaldson*. If that claim had been so interpreted, it would have been allowable since the cited references do not, singly or in combination, teach, suggest or provide motivation or incentive for the subject matter recited in those claims.

3.   Amendment of Claims 1, 5, 10, 17, 19 and 24-28.

Claims 1, 10, 17 and 24-28. Independent Claims 1, 10, 17 and 24-28 have been amended in order to expedite allowance of the instant case. The new content being content which contains images, and the comparison which involves image analysis has been adopted from independent Claims 27-28 as well as dependent Claim 18. These aspects being described in the specification including page 5, lines 10-11; page 9, lines 16-20; page 10, lines 1-10; page 13, lines 8-22; page 14, lines 8-23; page 15, lines 4-11; page 17, lines 10-16; and so forth. The line reciting "*wherein a content record is associated with existing content, with said content record having information fields for accessing duplicate content and/or related content,*", or similar phrasing, has been deleted from Claims 25-28 as seeming of limited clarification value.

Claims 5 and 19. Dependent Claims 5 and 19 have been amended herein to recite "*wherein image-content resolution is determined when comparing duplicate or related content*". This discussion of resolution in identifying records is described in the specification, including page 17, lines 10-14, also page 14, lines 1-4, and so forth.

4.   Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicant has made these amendments in order to expedite allowance of the currently pending subject matter. However, Applicant does not acquiesce in the original grounds for rejection with respect to the original form of these claims. These

amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicant reserves the right to pursue the original scope of these claims in the future, such as through continuation practice, for example.

5.   Conclusion.

Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

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Respectfully submitted,

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